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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			COFFY, EMMANUEL	
			ART UNIT	PAPER NUMBER
			2157	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,298

Applicant(s)

SMITH ET AL.

Examiner

Emmanuel Coffy

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the pre-appeal conference filed on 18 July 2005. Claims 1-23 are pending. Claims 1-23 are directed to a method, system and article of manufacture for "Active Electronic Messaging System."

Response to Arguments

2. Applicant's arguments have been considered but are moot in view of the new ground of rejection.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

37 CFR 3.73(b).

4. Claim 1 is rejected under the judicially created doctrine of double patenting over claims 1, 15, and 29 of U. S. Patent Application No. 09/613900 since the claim, if allowed, would improperly extend the "right to exclude" sought in above application.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somewhat a different recitation of application no. 09/613900. Moreover, claim 1 of the present invention and claim 1 of application no. 09/613900 are similar except for the following distinctions:

Assuming "content" in line 4 of application no. 09/613900 is the same as "content" in lines 8 and 9 of the same application under the broadest reasonable interpretation then there are two aspects to this analysis: an anticipatory and an obviousness. As to claim 1 under the anticipatory aspect, application no. 09/613900 recites "receiving a first message directed to a recipient utilizing a network, wherein the electronic message includes content; whereas the present invention recites "receiving the electronic message "eliminating" "directed to a recipient utilizing a network, wherein the electronic message includes content"; secondly application no. 09/613900 recites "storing the first message in a database"; which is eliminated in the present invention; thirdly, application no. 09/613900 recites transmitting the first message to the recipient utilizing the network; which is also eliminated in the present invention; fourthly, there is a species/genus relationship between 1) steps d) and e) of application 09/613900 and obtaining "CONTENT rather than command" from the message of the present invention and 2) step f) of application 09/613900 and performing a function responsive to the

CONTENT (command) instruction of the present invention.

Finally, as to equating content to command Uchida discloses "depending on the contents of a transmission command" at col. 2, line 30. There is no distinction between content and command in this context. Therefore, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art confronted with the problem of collecting massive amount of information to look to active messaging. Such system would provide for the automation of routine tasks.

As to claims 15 and 29 of application 09/613900 the same reasons given above apply.

Claim Objections

5. Claim 19 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim refers to "response" which is not recited in claim 17 from which it depends therefore broadening the scope of claim 17 rather than further limiting it.

6. Any claim, which depends upon claim 19, is objected to for claiming dependency upon an objected claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claim 1 is rejected under 35 U.S.C. §102(e) as being anticipated by Uchida et al. (US 6,327,610.)

Uchida substantially teaches the invention as claimed including a broadcast communication system in which a terminal unit for sending electronic mail data containing text of electronic mail, transmission destination data, a first command indicative of a transmission condition and a second command... (See abstract)

Claim 1:

Referring to claim 1, it recites a method for enhancing the functionality of an electronic message, comprising the steps of:

receiving the electronic message; (See Fig. 4, index 401; Fig. 5, index 504 and col. 1, lines 34-36.)

obtaining a command instruction from the electronic message; and (See Fig. 4, index 403, 404, 405 and col. 2, lines 1-27.)

performing a function responsive to the command instruction. (See col. 2, line 27-37)

10. Claims 11-12, 14, 17 and 18 are rejected under 35 U.S.C. §102(e) as being anticipated by Quine et al. (US 6,895,427.)

Quine teaches the invention as claimed including a method and system for forwarding an e-mail message intended to be delivered to a first e-mail address to a second e-mail address in the event the first e-mail address is disfavored.

See abstract.

Claim 11.

Quine teaches an article of manufacture including an information storage medium wherein is stored information for programming a computer to:

receive an electronic message having a destination address; (See Fig. 2 (102) and col. 5, lines 30-37.)

alter the destination address of the message; and (See Fig.3 (204 and col. 6, lines 5-15.))

send the message based on the altered destination address. (See Fig. 3 (210) and col. 6, lines 5-23.)

Claim 12.

Quine teaches an article of manufacture wherein information is stored for programming a computer as in claim 11, wherein the altered destination address identifies a computing device which will perform a function on the message. (See Fig. 3 (204), (210) and col. 6, lines 5-23.) (The computing device is the e-mail server of the intended recipient and the function performed on the message is that of storing it and informing the recipient that mail has arrived.)

Claim 14.

Quine teaches an article of manufacture wherein information is stored for programming a computer as in claim 11, wherein the message includes a return address, and wherein the computer is programmed to modify the return address to identify a computing device which will perform a function responsive to a returned message. (See Fig.3 (204 and col. 6, lines 5-15 and col. 2, lines 59-65.))

Claim 17:

Referring to claim 17, Quine teaches an apparatus for providing a function responsive to receiving a Request, comprising:

a processor; and (See Fig. 1)

a processor readable storage medium in communication with the processor, containing processor readable program code for programming the apparatus to: (See Fig. 1; hard drive, cd drive are inherent in today's processor)

receive the Request; (See Fig. 2 (100)) (by transmitting the e-mail the sender is in effect making a request that the e-mail be sent to the recipient.)

perform a function responsive to an instruction included in the Request; and,
(See Fig. 2 (104)) (in deciding whether there is a valid e-mail account, a function has been performed.)

prepare a Response subsequent to performing the function. (See Fig. 2, (110))
(in transmitting a message to sender, a response was prepared subsequent to performing the function.)

Claim 18:

Referring to claim 18, Quine teaches the apparatus of claim 17 as discussed above, wherein the Response includes instructions and data, wherein the instructions include information for disposal of the data. (See Fig. 2 (110), (112)). (the instructions indicate that the e-mail is undeliverable.)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. (US 6,327,610) in view of Ahmad (US 6,029,258.)

Claim 2:

Referring to claim 2, Uchida substantially teaches the method of claim 1 as discussed above. Uchida is silent about "wherein the command instruction indicates an

application provider for performing the function.” However, Ahmad explicitly discloses recommending a user to contact the provider of a software application. See col. 15, lines 4-30, especially lines 22-26. Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Uchita with the disclosure of Ahmad. Such system would ameliorate the time consuming, expensive and annoying downtime of computers and facilitate the automation of routine tasks.

Claim 4:

Referring to claim 4, Uchida substantially teaches the method of claim 1 as discussed above. Uchida is silent about “wherein the step of performing a function includes the steps of:

determining an application provider from the command instruction; and
sending a Request to the application provider to perform the function.”

However, Ahmad explicitly discloses recommending a user to contact to contact the provider of a software application which is interpreted as determining an application provider. See col. 15, lines 4-30, especially lines 22-26. Ahmad further discloses sending a Request to the application provider to perform the function. See col. 16, line 63-col. 17, line 9. Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Uchita with the disclosure of Ahmad. Such system would ameliorate the time consuming, expensive and annoying downtime of computers and facilitate the automation of routine tasks.

Claim 8:

Referring to claim 8, Uchida substantially teaches the method of claim 1. Uchida

is silent about "wherein the command instruction includes:

a host and a file which indicate an application provider for performing the function; and

at least one parameter which indicates information to be delivered to the application provider. "

However, Ahmad explicitly discloses above limitations at col. 15, lines 4-30. It is implicit that the software application provider has a host associated with its site.

Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Uchita with the disclosure of Ahmad. Such system would ameliorate the time consuming, expensive and annoying downtime of computers and facilitate the automation of routine tasks.

13. Claims 3, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. (US 6,327,610) in view of Tilden (US 6,449,635.)

Claim 3:

Referring to claim 3, Uchida substantially teaches the method of claim 1 as discussed above. Uchida is silent about "wherein the command instruction is a Uniform Resource Locator ("URL")." However, Tilden explicitly discloses said limitation (See col. 5, lines 30-34). Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Uchida with the disclosure of Tilden. Such system would ameliorate the time consuming, expensive and annoying downtime of computers and facilitate the automation of routine tasks.

Art Unit: 2157

Claim 9:

Referring to claim 9, Uchida substantially teaches the method of claim 1 as discussed above. Uchida is silent about “ wherein the command instruction is included in the received message as an Internet shortcut file.” However, Tilden explicitly discloses said limitation (See col. 5, lines 30-50). (it is implicit that http:// refers to the internet.)Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Uchida with the disclosure of Tilden. Such system would ameliorate the time consuming, expensive and annoying downtime of computers and facilitate the automation of routine tasks.

14. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. (US 6,327,610) in view of Ahmad (US 6,029,258) in further view of Borenstein (WO 92/22033.)

Claim 5:

Referring to claim 5, Uchida and Ahmad substantially teach the method of claim 4 as discussed above. Uchida and Ahmad are silent about “including the step of: preparing the Request based on the command instruction.”

However, Borenstein discloses at page 2, lines 7-8 that an active message is a program that is run. It is therefore, implicit that a running program can execute any step as implemented.

Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Uchida and Ahmad with the application provider determining process disclosed by Borenstein. Such system would provide for the automation of

routine tasks.

15. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. (US 6,327,610) in view of Ahmad (US 6,029,258) in further view of Richard (US 6,728,711.)

Claim 10:

Referring to claim 10, Uchida substantially teaches the method of claim 4 as discussed above. Uchida and Ahmad are silent about “wherein the Request is sent using an HTTP POST command.”

However, Richard does. (See abstract). Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Tilden and the application provider determining process disclosed by Uchida and Ahmad with HTTP POST as disclosed by Richard. Such system would provide for the automation of back-up and restoration tasks.

16. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. (US 6,327,610) in view of Ahmad (US 6,029,258) in further view of Quine et al. (US 6,895,427)

Claim 6.

Uchida and Ahmad substantially teach the method of claim 4 as discussed above. Uchida and Ahmad are silent as to “further including the steps of: receiving a Response from the application provider; and modifying the message responsive to receiving the Response.” However, Quine discloses a system which sends an e-mail message back to the sender which equates to receiving a Response from the

Art Unit: 2157

application provider (the ISP server). See col. 6, lines 10-23. Quine further discloses message modification responsive to the response. See col. 2, lines 59-65 and col. 5, line 60-col. 6, line 23 (particularly col. 6, lines 5-22.) Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Uchida and Ahmad with the system and method for cleansing addresses for electronic messages as disclosed by Quine. Such system would ameliorate the time consuming, expensive and annoying downtime of computers and facilitate the automation of routine tasks.

Claim 7.

Uchida and Ahmad substantially teach the method of claim 6 as discussed above. Uchida and Ahmad are silent as to "further including the step of: sending the modified message to a destination." However, Quine discloses a system which forwards the modified message to a destination. See col. 2, lines 59-65 and col. 5, line 60-col. 6, line 23 (particularly col. 6, lines 5-22.) Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Uchida and Ahmad with the system and method for cleansing addresses for electronic messages as disclosed by Quine. Such system would ameliorate the time consuming, expensive and annoying downtime of computers and facilitate the automation of routine tasks.

17. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quine et al. (US 6,895,427) in view of Ahmad (US 6,029,258)

Claim 13.

Quine substantially teaches an article of manufacture wherein information is stored for programming a computer as in claim 11 as discussed above. Quine is silent

as to "wherein the message includes a command instruction which indicates an application provider which will perform a function." However, Ahmad explicitly discloses recommending a user to contact the provider of a software application. See col. 15, lines 4-30, especially lines 22-26. Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Uchita with the disclosure of Ahmad. Such system would ameliorate the time consuming, expensive and annoying downtime of computers and facilitate the automation of routine tasks.

Claim 15.

Quine substantially teaches an article of manufacture wherein information is stored for programming a computer as in claim 13 as discussed above. Quine is silent as to "wherein the command instruction includes: a host and file which indicate the application provider for performing the function; and at least one parameter, and at least one associated value which indicates information to be delivered to the application provider." However, Ahmad explicitly discloses above limitations at col. 15, lines 4-30. It is implicit that the software application provider has a host associated with its site.

Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Uchita with the disclosure of Ahmad. Such system would ameliorate the time consuming, expensive and annoying downtime of computers and facilitate the automation of routine tasks.

18. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quine et al. (US 6,895,427) in view of Tilden (US 6,449,635.)

Claim 16.

Quine substantially teaches an article of manufacture wherein information is stored for programming a computer as in claim 11 as discussed above. Quine is silent as to "wherein a command instruction is included in the electronic message as an Internet shortcut file." However, Tilden explicitly discloses said limitation (See col. 5, lines 30-50). (it is implicit that http:// refers to the internet.) Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Uchita with the disclosure of Tilden. Such system would ameliorate the time consuming, expensive and annoying downtime of computers and facilitate the automation of routine tasks.

19. Claims 19, 20, 21 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Quine et al. (US 6,895,427) in view of Richard (US 6,728,711.)

Claim 19.

Quine substantially teaches the apparatus of claim 17 as discussed above. Quine is silent as to "wherein the processor readable program code for programming the computer to perform a function includes programming the computer to: deliver the Response using an HTTP POST command."

However, Richard does. (See abstract). Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Tilden and the application provider determining process disclosed by Borenstein with HTTP POST as disclosed by Richard. Such system would provide for the automation of back-up and restoration tasks.

Claim 20.

Quine teaches the apparatus of claim 19, wherein the Response includes at least one parameter that indicates information to be delivered, a value associated with at least one parameter, and a data stream. (See Fig. 2 (110), (112)). (the one parameter is the e-mail address, a value is the value of the information within the e-mail and the data stream is the content of the e-mail.)

Claim 21.

Quine substantially teaches the apparatus of claim 19 as discussed above.
Quine is silent as to “wherein the Request is in the form of an HTTP POST command.”

However, Richard does. (See abstract). Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Tilden and the application provider determining process disclosed by Borenstein with HTTP POST as disclosed by Richard. Such system would provide for the automation of back-up and restoration tasks.

Claim 22.

Quine teaches the apparatus of claim 19, wherein the Request includes a host , a file, at least one parameter that indicates information to be delivered, a value associated with at least one parameter, and a data stream. (See Fig. 2 (110), (112)). (the one parameter is the e-mail address, a value is the value of the information within the e-mail and the data stream is the content of the e-mail.)

20. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quine et al. (US 6,895,427) in view of Richard (US 6,728,711) in further view of Ahmad (US 6,029,258)

Claim 23.

Quine and Richard substantially teach the apparatus of claim 22 as discussed above, wherein the at least one parameter, and at least one associated value indicate information to be delivered to the apparatus.” (See ‘427 Fig. 2 (110), (112))). (the one parameter is the e-mail address, a value is the value of the information within the e-mail and the data stream is the content of the e-mail.) Quine and Richard are silent as to “wherein the host and file indicate the apparatus for providing the function;”

However, Ahmad explicitly discloses above limitations at col. 15, lines 4-30. It is implicit that the software application provider has a host associated with its site.

Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Uchita with the disclosure of Ahmad. Such system would ameliorate the time consuming, expensive and annoying downtime of computers and facilitate the automation of routine tasks.

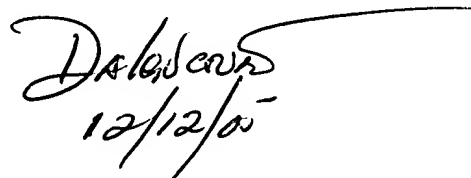
CONCLUSION

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Coffy whose telephone number is (571) 272-3997. The examiner can normally be reached on 8:30 - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Emmanuel Coffy
Patent Examiner
Art Unit 2157



12/12/05

EC
November 29, 2005